REMARKS

This is a full and timely response to the non-final Office Action mailed on November 16, 2005 (Paper No./Mail Date 110905). Reconsideration and allowance of the Application and present claims are respectfully requested. Applicants should not be presumed to agree with any statements made by the Examiner regarding the rejections and objections made in the Office Action unless otherwise specifically indicated by Applicants.

1. Restriction Requirement

Applicant confirms its election with traverse of Group I, claims 1-17 by telephone on November 2, 2005. Applicant has annotated claims 18-20 to reflect that they are withdrawn in view of this election.

2. Response to Claim Rejection Under 35 U.S.C. §112

Claim 16 is amended to change its dependency to claim 15 instead of claim 19 in order to traverse this rejection. It would appear obvious from a reading of the original claims that claim 16 was intended to depend upon claim 15 and that its reference to claim 19 was a typographical error.

3. Claims Rejections Under 35 U.S.C. §103(a)

Claims 1, 2, 6-13 and 17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hoesman (U.S. Patent 4,734,232) in view of Kearns, et al. (U.S. 4,783,295) and Raynor, et al. (U.S. Patent 3,882,052).

The Office Action comments that Hoesman discloses or suggests the basic claimed method for flat proofing a tire and wheel assembly. Applicants respectfully disagree with this characterization of Hoesman. Hoesman does not teach or suggest flat proofing a tire and wheel assembly. Hoesman teaches fabricating a solid tire having a polyurethane foam core by mounting a jig centered on the tire, then filling inside of the tire with a mixture of polyol and isocyanate, then removing the jig from the tire while the core material is still expanding, then after the urethane foam has cured, mounting the tire on a wheel hub. See, e.g., Abstract. Accordingly, Hoesman does not teach or suggest injecting a mixture of reactant materials into a tire and wheel assembly, nor does it teach or suggest allowing the mixture of reactant materials to react within the tire and wheel assembly to create foam fill within the tire and wheel assembly, nor does it teach curing the foam

fill within the tire and wheel assembly, as recited in claim 1 as amended. Claim 1 has been amended to correct and clarify the antecedent references within the claim.

Further, the Office Action acknowledges Hoesman does not teach or suggest the use of a static mixer or supplying a nucleating gas to the static mixer. The Office Action relies on the Kearns, et al. and Raynor, et al. references to fill these admitted voids in the teachings of Hoesman. Neither Kearns, et al. nor Raynor, et al. teach or suggest foam filling a tire and wheel assembly. Kearns, et al. teaches a process for preparing molded microcellular elastomers involving introducing into a first reactant a gas to form an admixture of the first reactant and a gas, then passing the admixture through a static mixer at super atmospheric pressure, then immediately mixing the admixture of the first reactant and gas with a second reactant at super atmospheric pressure to form a reaction mixture and then introducing the reaction mixture into a closed mold. See, e.g., Abstract; and Col. 1, line 26. The super atmospheric pressure taught is greater than about 300 psi and most preferably between 1800 to 2000 psi. Col. 4, lines 53-56. Thus, Kearns, et al. teach injection molding of a product, not producing a foam filled tire and wheel assembly. Additionally, Kearns, et al. teach away from supplying nucleating gas to the static mixer at a pressure sufficient to entrain the gas in the mixture of reactant materials in the static mixer. Instead, gas is introduced prior to the static mixer. The pressures taught by Kearns, et al. are such that supplying a nucleating gas to the static mixer at a pressure sufficient to entrain the gas in the mixture of reactant materials when the reactant materials are already at super atmospheric pressure would be difficult. With reference to claims 9 and 10, Kearns, et al. teach use of a closed mold as opposed to filling a tire in which a vent hole is provided allowing trapped air to escape through the vent hole.

The Office Action acknowledges that Kearns, et al. fail to teach the introduction of the gas directly to a static mixer. The Office Action relies on Raynor, et al. for this feature. Raynor, et al., a previously noted, also fails to teach foam filling a tire and wheel assembly. Raynor, et al. teach making foam-core structural panels and poured-in-place foam building insulation. See Col. 1, lines 10-12. Additionally, the passage relied upon by the Examiner, namely, Col. 5, lines 41-49, discloses supplying a nucleating gas at a sufficient pressure, i.e., usually above about 60 psig. Such a pressure would be inadequate in the case of Kearns, et al. where super atmospheric pressure in the

static mixer is involved. Thus, the teachings of Raynor et al. are not combinable with those of Kearns et al.

Applicant takes issue with the statement in the Office Action that "appropriate operating conditions, as in claims 12 and 13, would have been readily determined through routine experimentation by one of ordinary skill in the art and Official Notice is taken that it is known to introduce foam into tubed tires, as in claim 17", presented at the end of the full paragraph on page 3. The first statement is nothing more than a bare assertion that something is a design choice. Such an assertion, however, is insufficient to establish any "suggestion" in the art for the claimed invention. See, e.g., *Northern Telecom, Inc. v. Datapoint Corp.*, 15 U.S.P.Q.2nd 1321, 1323 (Fed. Cir. 1990). As set forth by the Board of Patent Appeals and Interferences, the statement that something is a design choice is a conclusion and not a reason. Ex parte Garrett, 1986 Pat., APP. LEXIS 8, (Bd. Pat. App. Interferences, 1986). The Office Action has not provided sufficient motivation for the claimed invention nor provided a reference teaching or suggesting foam filling a tire and wheel assembly. The Office Action has not established a prima facia case of obviousness and the rejection should be withdrawn. Additionally, whether or not it is known to introduce foam into tubed tires fails to present a teaching or suggestion for foam filling a tire and wheel assembly.

Claims 3-5 and 14 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Hoesman in view of Kearns, et al. and Raynor, et al. and further in view of Trickel, et al. (U.S. Patent 4,440,208). Trickel, et al., however, also fails to teach foam filling a tire and wheel assembly. Trickel, et al. does not involve foam. Instead, Trickel, et al. discloses filler material comprised of reducing scrap rubber articles to the form of small pieces, compressing the pieces into a mold separate from the tire, and heating the compressed pieces in the mold at a temperature of from 100°F to 600°F while applying a pressure of from 500 to 4000 psi. These mold contents are then consolidated and removed from the mold and placed into a suitable tire casing. Thus, Trickle et al. is not relevant to Applicants' claimed invention.

Lastly, claims 15 and 16 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Hoesman in view of Kearns, et al. and Raynor, et al, and further in view of Doyle, et al. (U.S. Patent 4,248,811). This combination of references in inconsistent with the teachings of Doyle et al. Doyle et al. does not disclose supplying nucleating gas to a static mixer. In fact, Doyle et al. teach that all of the components supplied to the mixer should be liquid. See, e.g., Col. 6, lines 20-22.

Further, these claims are allowable for the same reasons as claims 1, 2, 6-13 and 17 discussed above.

4. New Claims 21-24

New claims 21-23 are presented dependent upon claim 1. These claims are believed allowable for the same reasons as claim 1 discussed above. Additionally, Applicant notes that each of these claims is separately allowable for the reason that the feature recited in each of these claims is not taught or suggested by any of the cited references.

New independent claim 24 is added which is a combination of originally presented claims 1, 7, 9 and 10, along with new claim 21. New claim 24 is believed allowable for the same reasons of these claims as discussed above.

CONCLUSION

Applicants respectfully maintain that the currently pending claims 1-17 and 21-24 are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned attorney at 770-933-9500.

Respectfully submitted,

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